UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/766,319	01/26/2004	Vikram Madan	306171.01/MFCP.153380	1220

45809   7590   10/25/2010
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EXAMINER
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ART UNIT	PAPER NUMBER
2164	

MAIL DATE	DELIVERY MODE
10/25/2010	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

	Application No.	Applicant(s)
Office Action Summary	10/766,319	MADAN ET AL.
	Examiner	Art Unit	
	ALICIA M. LEWIS	2164	

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on <u>03 September 2010</u>.

2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) <u>10,11,15,17,18,20,22,24-28 and 30-37</u> is/are pending in the application.

  4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) <u>10,11,15,17,18,20,22,24-28 and 30-37</u> is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.

  Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

  Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

  a) ☐ All b) ☐ Some * c) ☐ None of:

    1. ☐ Certified copies of the priority documents have been received.

    2. ☐ Certified copies of the priority documents have been received in Application No. _____.

    3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

  * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
  Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
  Paper No(s)/Mail Date. _____

5) ☐ Notice of Informal Patent Application

6) ☐ Other: _____.

DETAILED ACTION

This non-final office action is responsive to the Request for Continued

Examination (RCE) filed September 3, 2010. Claims 10, 20, 22, 27 and 28 are currently

amended, and claim 21 is additionally canceled. Therefore claims 10, 11, 15, 17, 18,

20, 22, 24-28 and 30-37 remain pending in this application.

Claim 36 depends on canceled claim 21. For the purposes of compact

prosecution, the Examiner will assume claim 36 depends on claim 10 and

examine it as such. Appropriate correction is required.

Claim Rejections - 35 USC § 112

1.   The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of
> making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the
> art to which it pertains, or with which it is most nearly connected, to make and use the same and shall
> set forth the best mode contemplated by the inventor of carrying out his invention.

2.   Claims 22, 24, 27, 28 and 31 are rejected under 35 U.S.C. 112, first paragraph,

as failing to comply with the written description requirement. The claim(s) contains

subject matter which was not described in the specification in such a way as to

reasonably convey to one skilled in the relevant art that the inventor(s), at the time the

application was filed, had possession of the claimed invention. Claims 22, 27 and 28

have been amended to include a limitation of a first pointer between the context

information and content (or textual region) and a second pointer between the additional

context information and content (or textual region). Applicant points to paragraph 59 of

the original specification to support this amendment.

3.   However, paragraph 59 does not provide sufficient support for the new limitation.

Applicant's specification supports a first pointer 903 that points from context 902 to

content 901 and a second pointer 904 that points from content 901 to context 902.

Although Applicant describes two different pointers, the pointers described by Applicant

are not the same as the claimed two pointers. There is no description of a second

pointer that points between additional context information and content, as claimed. The

pointers described in the specification only point between content and a single context

902, not additional context. In fact, the pointers described in the specification represent

reverse or opposite pointers between the same two objects. Therefore, the limitation of

a first pointer between the context information and content (or textual region) and a

second pointer between the additional context information and content (or textual

region) represents new matter.

4.   Claims 24 and 31 are rejected as being dependent upon rejected claims 27 and

28, respectively.

5.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly
> claiming the subject matter which the applicant regards as his invention.

6.   Claim 36 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite

for failing to particularly point out and distinctly claim the subject matter which applicant

regards as the invention. The limitation "any subsequent sets of textual characters

reside outside the path drawn by the user" is unclear. Any textual characters not in the

selected region when the region is selected are inherently outside the path drawn.

Appropriate correction is required.

Claim Rejections - 35 USC § 103

7.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

8.   Claims 10, 20, 30, 36 and 37 are rejected under 35 U.S.C. 103(a) (*current*

application filing date 1/26/2004) as being unpatentable over Denoue et al. (US

2004/0119762 A1, *filing date 12/24/2002*) ('Denoue') in view of Dawe et al. (US

7,042,594 B1, *filing date 3/7/2000*) ('Dawe'), further in view of Woolf et al. (WO

01/42980 A1) ('Woolf'), and further in view of Saund et al. (US 2003/0182630 A1)

('Saund').

9.   With respect to claim 10, Denoue teaches:

        setting a mode of operation to a content capture mode for interpreting user input

for the purpose of selecting an on-screen region of a display (paragraphs 56, 75-78 and

86), and receiving a path drawn by a user (paragraphs 54 and 86), the path defining

boundaries of the selected region of the display (paragraph 59), wherein pixels

comprising one or more graphical elements representing a first set of one or more

textual characters are displayed in the selected on-screen region (Figure 6, paragraphs

67 and 71-72) (*Denoue teaches that the word "awareness" may be a standalone object that may be selected by itself, and further that "increased awareness" may be looked at or segmented as two parts.*);

capturing the pixels displayed within the selected on-screen region (paragraphs 67 and 86-87), and storing the captured pixels (paragraph 89);

receiving an annotation (*i.e. freeform ink*) drawn by a user on the display (Figs. 2-5 and paragraphs 55 and 57);

obtaining context information for the one or more graphical elements by automatically applying text recognition (paragraph 79) to the annotation (*i.e. freeform inks 532, 534, 536 and freeform notes*) (paragraphs 57 and 75) (*OCR may be applied to captured content and captured content may include freeform inks, as seen in figs. 2-5*);

obtaining additional context information by extracting the first set of one or more textual characters and extracting a second set of textual characters displayed in proximity with the first set (paragraphs 71-72 and 79) (*Denoue teaches a first set of characters "increased", which may be separate from the second set of characters "awareness," which is in proximity to the first set. He further teaches performing OCR on text to extract information.*),

wherein context information is stored in association with the captured data (paragraphs 75-76).

Denoue does not explicitly teach storing captured data in an image file; storing the results of text recognition as context information via the computer system; or

automatically storing context information and additional context information in association with the image file.

Dawe teaches a system and method for saving handwriting as an annotation in a scanned document (see abstract), in which he teaches:

capturing image pixels and storing captured image pixels in an image file (col. 3 lines 60-63, col. 7 line 61- col. 8 line 4);

applying text recognition to annotations and storing the results of text recognition as context information via the computer system (col. 5 lines 52-60, col. 7 lines 6-20 and 61-65); and

automatically storing context information and additional context information in association with the image file (col. 7 lines 57-65).

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Denoue by the teaching of Dawe because storing captured data in an image file; storing the results of text recognition as context information; or automatically storing context information in association with the image file would enable handwriting to be saved as an annotation, and thus reduce clutter in a document presented to a user, while maintaining the information conveyed by the handwriting for presentation to the user if desired (Dawe, abstract).

Further regarding claim 10, Denoue in view of Dawe does not teach switching the mode of operation to an annotation mode in response to a user command; or wherein the received annotation is implemented using a plurality of tools via a toolbar, the

toolbar appearing after selecting a button.

Woolf teaches a system and method for annotating an electronic document independently of is content (see abstract), in which he teaches switching the mode of operation to the annotation mode in response to a user command; and

receiving an annotation drawn by the user on the display (Figures 4 and 5, page 7 lines 24-26), wherein the received annotation is implemented using a plurality of tools via a toolbar, the toolbar appearing after selecting a button (Figure 4, page 7 lines 5-14).

Woolf teaches a user interface on a screen that has a toolbar at the bottom of the screen (Figure 4). Further, the annotation menu 402 may be considered a toolbar because it includes interactive buttons that may be clicked to activate a tool (i.e. ink mode, selection mode, highlight mode or erase mode). The annotation menu appears in response to tapping or selecting a button.

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to have further modified Denoue by the teaching of Woolf to enable users the ability to annotate pages of a document without changing the contents of the document (Woolf, page 2 lines 14-15).

Further regarding claim 10, Denoue in view of Dawe and Woolf fails to explicitly teach the toolbar (or menu) appearing after selecting an on screen region.

Saund teaches a method for gestural interpretation in a system for selecting and arranging visible material in document images (see abstract), in which he teaches a

toolbar appearing after selecting an on-screen region (paragraphs 29-30).

Sound teaches that a user draws a path that encloses or partially encloses at least one object. In response to this gesture, a pop-up menu choose box 320 appears. The pop-up menu may be considered a toolbar because the select button is an interactive button that may be clicked to activate a selection tool. Further, Sound teaches that tools are usually provided by menus (paragraph 5).

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to have further modified Denoue by the teaching of Sound to enable users the ability to enter, select or modify data without pre-selecting an input mode (Saund, abstract).

With respect to claim 20, Denoue in view Dawe, Woolf and Saund teaches wherein the context information is stored in such a manner as to be accessible to the user for performing at least one of the following:

searching for said context information;

displaying the context information simultaneously with the captured pixels (Denoue, paragraphs 75-76; Dawe, col.8 lines 1-16), and

navigating a network to a source of the captured pixels.

With respect to claim 30, Denoue in view Dawe, Woolf and Saund teaches wherein the annotation is stored as originally drawn as additional context information in association with the image file (Dawe, col. 7 lines 9-11, 18-20 and 57-65).

With respect to claim 36, Denoue in view Dawe, Woolf and Sound teaches determining that the second sets of textual characters reside within the path drawn by the user and any subsequent sets of textual characters reside outside the path drawn by the user (Dawe, col. 7 lines 11-16). *Dawe teaches that it is determined that the word "job" resides within the path drawn. It is inherent that any subsequent characters (i.e. characters that are not in the region when the region is selected) will be outside the path drawn.*

With respect to claim 37, Denoue in view Dawe, Woolf and Sound teaches wherein the received annotation is implemented using a plurality of tools via a toolbar (Woolf, Figure 4, page 7 lines 5-14), the toolbar appearing after a stylus has been lifted off the display (Sound, paragraphs 29-30). *Sound teaches that the pop-up menu (i.e. toolbar) appear after a path has been drawn, meaning the stylus has been lifted.*

10.   Claim 11, 25 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Denoue et al. (US 2004/0119762 A1, *filing date 12/24/2002*) ('Denoue') in view of Dawe et al. (US 7,042,594 B1, *filing date 3/7/2000*) ('Dawe'), Woolf et al. (WO 01/42980 A1) ('Woolf'), and Saund et al. (US 2003/0182630 A1) ('Saund'), as applied to claims 10, 20, 30, 36 and 37 above, and further in view of Oppermann et al. (US 6,334,157 B1, *filing date 3/11/1997*) ('Oppermann').

With respect to claim 11, Denoue in view of Dawe, Woolf and Saund teaches claim 10, including a selected on-screen region and automatically storing context information in association with the image file (Dawe, col. 7 lines 57-65).

Denoue in view of Dawe, Woolf and Saund does not teach determining a window associated with the selected on-screen region; retrieving an application interface having a uniform resource identifier (URI) property from the determined window or parent window of the determined window; or obtaining the URI property as additional context information.

Oppermann teaches programmatically providing direct access to user interface elements of an application program (see abstract), in which he teaches:

selecting user interface elements, such as text (col. 8 lines 43 and 49-51) and determining a window associated with the selected elements (col. 26 lines 37-40);

retrieving an application interface having a uniform resource identifier (URI) property from the determined window or parent window of the determined window (col. 25 lines 59-62, col. 28 lines 33-39); and

obtaining the URI property as additional context information (col. 11 lines 1-9, 55-60, col. 12 lines 55-60, col. 13 lines 51-60).

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to have further modified Denoue by the teaching of Oppermann because determining a window, retrieving an application interface having a uniform resource identifier (URI) property from the determined window or parent window of the determined window would enable accessibility aids the ability to access and manipulate

user interface elements of any application program without having prior knowledge of

the application program or its interface (Oppermann, column 4 lines 27-30).

      With respect to claim 25, Denoue in view of Dawe, Woolf, Saund and

Oppermann teaches wherein the selected on-screen region includes at least a portion

of a displayed web page or document (Dawe, Figure 4, col. 4 lines 38-42), and the

method further comprises: using an application programming interface (API) to query an

application for additional context information (Oppermann, column 7 lines 36-38), the

additional context information being automatically stored in association with the image

file (Dawe, col. 7 lines 57-65), the queried application causing the one or more graphical

elements to be displayed (Oppermann, column 7 lines 36-45; Denoue, paragraphs 86-

87).

      With respect to claim 26, Denoue in view of Dawe, Woolf, Saund and

Oppermann teaches further comprising obtaining a uniform resource identifier (URI) of

the web page or document as the context information (Oppermann, col. 11 lines 1-9,

55-60, col. 12 lines 55-60, col. 13 lines 51-60), the URI being obtained as a result of the

query using the API (Oppermann, column 7 lines 36-38).

11.   Claims 15, 18, 32 and 33 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Denoue et al. (US 2004/0119762 A1, *filing date 12/24/2002*)

('Denoue') in view of Dawe et al. (US 7,042,594 B1, *filing date 3/7/2000*) ('Dawe'), Woolf

et al. (WO 01/42980 A1) ('Woolf'), and Saund et al. (US 2003/0182630 A1) ('Saund'), as

applied to claims 10, 20, 30, 36 and 37 above, and further in view of Browne et al. (US

2004/0135815 A1, *filing date 12/15/2003*) ('Browne').

With respect to claim 15, Denoue in view of Dawe, Woolf and Saund teaches

claim 10.

Denoue in view of Dawe, Woolf and Saund does not teach creating and storing a

linking structure as the association between the image file and the context information.

Browne teaches a method and apparatus for image metadata entry (see

abstract), in which he teaches creating and storing a linking structure as the association

between the image file and the context information (Figure 12, paragraph 136).

It would have been obvious to a person having ordinary skill in the art at the time

the invention was made to have further modified Denoue by the teaching of Browne

because teach creating and storing a linking structure as the association between the

image file and the context information would enable an easy and efficient method of

classifying and storing digital images (Browne, paragraph 14).

With respect to claim 18, Denoue in view of Dawe, Woolf, Saund and Browne

teaches wherein the linking structure includes at least one pointer pointing to the stored

image file or the stored content information (Browne, paragraph 136).

With respect to claim 32, Denoue in view of Dawe, Woolf, Saund and Browne

teaches a link to the one or more graphical elements of the selected on-screen region,

the link comprising one of an implicit link hidden behind the one or more graphical

elements and an explicit link shown in conjunction with the one or more graphical

elements (Browne, paragraph 136). (*Browne teaches metadata-image associations, in*

which pointers are stored between images and metadata).

With respect to claim 33, Denoue in view of Dawe, Woolf, Saund and Browne

teaches a separate linking table or database entry utilizing one or more pointers to the

one or more graphical elements (Browne, paragraph 136). (*Browne teaches metadata-*

image associations, in which pointers are stored between images and metadata).

12.   Claims 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over

Denoue et al. (US 2004/0119762 A1, *filing date 12/24/2002*) ('Denoue') in view of Dawe

et al. (US 7,042,594 B1, *filing date 3/7/2000*) ('Dawe'), Woolf et al. (WO 01/42980 A1)

('Woolf'), and Saund et al. (US 2003/0182630 A1) ('Saund'), as applied to claims 10, 20,

30, 36 and 37 above, and further in view of Barsness et al. (US 2004/0201633 A1)

('Barsness').

With respect to claim 22, Denoue in view Dawe, Woolf and Saund teaches

wherein the selected on-screen region is part of a displayed textual region, and the

graphical elements comprise a first set of one or more textual characters displayed in

the textual region, the method further comprising: obtaining additional context

information based on a second set of one or more textual characters displayed in the

textual region (Dawe, Fig. 4, col. 7 lines 6-20 and lines 61-65; Denoue, paragraph 72),

the additional context information being automatically stored in association with the

image file (Dawe, col. 7 lines 57-65) (*The words "job" in Dawe or "awareness" in*

Denoue may be considered the second set of textual characters).

Denoue in view of Dawe, Woolf and Saund fails to teach obtaining a first pointer

between the context information and the textual region, and obtaining a second pointer

between the additional context information and the textual region, wherein the first

pointer differs from the second pointer.

Barsness teaches a handheld electronic book reader with annotation and usage

tracking capabilities (see abstract), in which he teaches obtaining a first pointer between

the context information and the textual region, and obtaining a second pointer between

the additional context information and the textual region, wherein the first pointer differs

from the second pointer (paragraphs 36, 49 and 61-62). (*Barsness teaches a term is*

associated with a context list that has one or more context records 69, each context

record including either a copy of a section of text or a pointer to the actual content in an

electronic document. The term represents a textual region, and each term may be

associated, by pointers, with different contexts of the document.)

It would have been obvious to a person having ordinary skill in the art at the time

the invention was made to have further modified Denoue by the teaching of Barsness to

enable improved functionality and utility of electronic documents by enhancing the

collaborative and annotative capabilities of electronic book readers or other similar

handheld devices capable of rendering electronic documents (Barsness, abstract,

paragraph 22).

13.   Claims 32 and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable

over Denoue et al. (US 2004/0119762 A1, *filing date 12/24/2002*) ('Denoue') in view of

Dawe et al. (US 7,042,594 B1, *filing date 3/7/2000*) ('Dawe'), Woolf et al. (WO 01/42980

A1) ('Woolf'), and Saund et al. (US 2003/0182630 A1) ('Saund'), as applied to claims

10, 20, 30, 36 and 37 above, and further in view of Hertzfeld et al. (US 2002/0076109

A1, *filing date 1/25/1999*) ('Hertzfeld').

        With respect to claim 32, Denoue in view of Dawe, Woolf and Saund teaches

claim 10.

        Denoue in view of Dawe, Woolf and Saund does not teach a link to the one or

more graphical elements of the selected on-screen region, the link comprising one of an

implicit link hidden behind the one or more graphical elements and an explicit link

shown in conjunction with the one or more graphical elements.

        Hertzfeld teaches a method and apparatus for context sensitive text recognition

(see abstract), in which he teaches a link to the one or more graphical elements of the

selected on-screen region, the link comprising one of an implicit link hidden behind the

one or more graphical elements and an explicit link shown in conjunction with the one or

more graphical elements (elements 608 and 616 in Fig. 6, paragraph 38).

        It would have been obvious to a person having ordinary skill in the art at the time

the invention was made to have further modified Denoue by the teaching of Hertzfeld

to enable recognition of predefined types of text and predefined actions to be

performed based on the types of text (Hertzfeld, abstract).

With respect to claim 35, Denoue in view of Dawe, Woolf, Saund and Hertzfeld

teaches wherein the one or more graphical elements comprise underlying data,

underlying objects, and underlying associations with remote content (Hertzfeld, Fig. 6,

paragraph 38).

14.   Claim 34 is rejected under 35 U.S.C. 103(a) as being unpatentable over Denoue

et al. (US 2004/0119762 A1, *filing date 12/24/2002*) ('Denoue') in view of Dawe et al.

(US 7,042,594 B1, *filing date 3/7/2000*) ('Dawe'), Woolf et al. (WO 01/42980 A1)

('Woolf'), and Saund et al. (US 2003/0182630 A1) ('Saund'), as applied to claims 10, 20,

30, 36 and 37 above, and further in view of Chan (US 2006/0100849 A1).

With respect to claim 34, Denoue in view of Dawe, Woolf and Saund teaches

claim 10.

Denoue in view of Dawe, Woolf and Saund does not teach displaying the

obtained context information to the user as one of displaying a property in a window and

hovering over the one or more graphical elements.

Chan teaches a system for providing a user bilingual annotations (see abstract),

in which he teaches displaying the obtained context information to the user as one of

displaying a property in a window and hovering over the one or more graphical

elements (paragraphs 11, 49 and 66) (*Chan teaches that translated versions of text*

objects may be displayed when the pointer is adjacent to or overlaid by a user's

pointer).

It would have been obvious to a person having ordinary skill in the art at the time

the invention was made to have further modified Denoue by the teaching of Chan to

enable an annotation tool providing annotations in multiple languages, thereby making

documents accessible to more users (Chan, abstract, paragraph 14).

15.   Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Denoue

et al. (US 2004/0119762 A1, *filing date 12/24/2002*) ('Denoue') in view of Dawe et al

(US 7,042,594 B1, *filing date 3/7/2000*) ('Dawe'), Woolf et al. (WO 01/42980 A1)

('Woolf'), Saund et al. (US 2003/0182630 A1) ('Saund'), and Browne et al. (US

2004/0135815 A1, *filing date 12/15/2003*) ('Browne'), as applied to claims 15 and 18

above, and further in view of Newman (US 2003/0101156 A1, *filing date 11/26/2001*).

With respect to claim 17, Denoue in view of Dawe, Woolf, Saund and Browne

teaches claim 15.

Denoue in view of Dawe, Woolf, Saund and Browne does not teach wherein the

linking structure is incorporated in a file separate from the stored image file and the

stored content information.

Newman teaches database systems and methods (see abstract), in which he

teaches wherein the linking structure is incorporated in a file separate from the stored

image file and the stored content information (paragraph 16).

It would have been obvious to a person having ordinary skill in the art at the time

the invention was made to have further modified Denoue by the teaching of Newman

because wherein the linking structure is incorporated in a file separate from the stored

image file and the stored content information would enable additional information about

image files, such as the origination device, person who created the file, and data/time

the file was created, to be transmitted and stored along with the image files (Newman,

paragraph 16).

16.   Claims 24 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable

over Denoue et al. (US 2004/0119762 A1, *filing date 12/24/2002*) ('Denoue') in view of

Dawe et al (US 7,042,594 B1, *filing date 3/7/2000*) ('Dawe'), further in view of Hertzfeld

et al. (US 2002/0076109 A1, *filing date 1/25/1999*) ('Hertzfeld'), further in view of Chan

(US 2006/0100849 A1), and further in view of Browne et al. (US 2004/0135815 A1)

('Browne').

With respect to claim 27, Denoue teaches:

receiving a path drawn on a display via user input (paragraphs 54 and 86), the

drawn path defining boundaries of a selected on-screen region of the display, the

selected on-screen region comprising a plurality of pixels (Figure 6, paragraphs 59 and

67);

capturing the plurality of pixels of the on-screen region (paragraphs 67 and 86-87); and

storing the captured image pixels (paragraph 89);

extracting a character or word from textual data as context information via the computer system (paragraph 79); and

storing the extracted context information in association with the captured data (paragraphs 75-76).

Denoue does not teach: storing captured data in an image file; automatically extracting a character or word from the textual data as context information in response to automatically determining that the displayed content of the on-screen region includes the textual data via the computer system; or storing the extracted context information and additional context information in association with the image file via the data storage subsystem, such that the context information is accessible when viewing the image file.

Dawe teaches a system and method for saving handwriting as an annotation in a scanned document (see abstract), in which he teaches:

capturing image pixels and storing captured image pixels in an image file (col. 3 lines 60-63, col. 7 line 61- col. 8 line 4);

automatically extracting a character or word from the textual data as context information in response to automatically determining that the displayed content of the on-screen region includes the textual data via the computer system (col. 7 lines 6-8

and 15-20); and

storing the extracted context information and additional context information in association with the image file via the data storage subsystem, such that the context information is accessible when viewing the image file (col. 7 lines 57-60, col. 8 lines 1-16).

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Denoue by the teaching of Dawe to enable handwriting to be saved as an annotation, and thus reduce clutter in a document presented to a user, while maintaining the information conveyed by the handwriting for presentation to the user if desired (Dawe, abstract).

Further regarding claim 27, Denoue in view of Dawe does not teach a displayed content of the selected on-screen region includes both textual data and underlying data comprising at least one of: an executable object, a file, or a link to remote content; or automatically extracting a property of the underlying data as additional context information in response to determining that the displayed content of the on-screen region includes underlying data via the computer system, the property comprising at least one of: a file name, a file identifier, a uniform resource locator (URL), a uniform resource identifier (URI), a folder name, or meta-data.

Hertzfeld teaches a method and apparatus for context sensitive text recognition (see abstract), in which he teaches:

a displayed content of the selected on-screen region includes both textual data

and underlying data comprising at least one of: an executable object, a file, or a link to
remote content (Hertzfeld, steps 602 and 608 in Figure 6, paragraph 38); and

automatically extracting a property of the underlying data as additional context
information in response to determining that the displayed content of the on-screen
region includes underlying data via the computer system, the property comprising at
least one of: a file name, a file identifier, a uniform resource locator (URL), a uniform
resource identifier (URI), a folder name, or meta-data (step 616 in Figure 6, paragraph
38).

It would have been obvious to a person having ordinary skill in the art at the time
the invention was made to have further modified Denoue by the teaching of Hertzfeld
because the content of the selected on-screen region includes both textual data and
underlying data comprising at least one of: an executable object, a file, or a link to
remote content; and in response to determining that the displayed content of the on-
screen region includes underlying data, automatically extracting a property of the
underlying data as additional context information, the property comprising at least one
of: a file name, a file identifier, a uniform resource locator (URL), a uniform resource
identifier (URI), a folder name, and meta-data would enable recognition of predefined
types of text and predefined actions to be performed based on the types of text
(Hertzfeld, abstract).

Further regarding claim 27, Denoue in view of Dawe and Hertzfeld does not
teach extracting complete sentences based upon punctuation.

Chan teaches a system and method for providing bilingual annotations (see abstract), in which he teaches extracting complete sentences based upon punctuation (paragraph 77).

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to have further modified Denoue by the teaching of Chan to enable an annotation tool providing annotations in multiple languages, thereby making documents accessible to more users (Chan, abstract, paragraph 14).

Further regarding claim 27, Denoue in view of Dawe, Hertzfeld and Chan does not teach pointing a first pointer from the context information to the displayed content; or pointing a second pointer from the additional context information to the displayed content.

Browne teaches a method and apparatus for image metadata entry (see abstract), in which he teaches pointing a first pointer from the context information to the displayed content; and pointing a second pointer from the additional context information to the displayed content (paragraphs 136 and 142). (*Browne teaches storing metadata-image (i.e. context-content) associations using pointers. He further teaches that metadata records comprise references (i.e. pointers) to images.*)

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to have further modified Denoue by the teaching of Browne to enable an easy and efficient method of classifying and storing digital images, including images of text (Browne, paragraph 14).

With respect to claim 24, Denoue in view of Dawe, Hertzfeld, Chan and Browne teaches:

digitizing movements of a stylus across the display in order to receive the annotation (Denoue, paragraphs 55, 57 and 75); and

obtaining additional context information based on the received annotation (Denoue, paragraph 79), the additional context information being automatically stored in association with the image file (Dawe, col. 7 lines 57-65).

17.   Claims 28 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dawe et. al (US 7,042,594 B1, *filing date 3/7/2000*) ('Dawe') in view of Woolf et al. (WO 01/42980 A1) ('Woolf'), further in view of Hertzfeld et al. (US 2002/0076109 A1, *filing date 1/25/1999*) ('Hertzfeld'), and further in view of Barsness et al. (US 2004/0201633 A1) ('Barsness').

With respect to claim 28, Dawe teaches:

receiving a display of content comprising at least one of textual data, an executable object, a file, or a link to remote content (col. 6 lines 42-48, col. 4 lines 46-59, col. 7 lines 38-40);

receiving a path drawn on the display which defines boundaries of a selected on-screen region of the content via user input (col. 5 lines 28-30; col. 6 lines 42-51);

capturing and storing the selected content as an image file via the data storage

subsystem (col. 3 lines 60-63, col. 7 lines 40-42 and lines 61-65, col. 8 lines 1-3);

performing text recognition on a received annotation as context information (col. 7 lines 6-20);

automatically determining via the computer system that the content displayed within the on-screen region includes textual data and underlying data (col. 6 lines 52-53, col. 7 lines 11-20 and 35-40);

automatically extracting as additional context information:

a bounded region comprising a character or word from the textual data determined to be included in the on-screen region (col. 7 lines 6-20 and 57-65, col. 8 lines 19-26), and determining if the character or word lies completely within the bounded region (col. 7 lines 11-16) (*Dawe teaches that it is determined whether the region includes any handwriting using handwriting detection logic. Therefore, the handwriting detection logic determines if any handwriting (i.e. at least one character) lies completely within the region.*); and

storing the context information and the additional context information in association with the image file via the data storage subsystem, such that the context information is accessible when viewing the image file (col. 7 lines 57-60, col. 8 lines 1-16).

Further regarding claim 28, Dawe does not teach setting a mode of operation to a content capture mode; switching the mode of operation to an annotation mode; or receiving an annotation on the display via the input device; or.

Woolf teaches a system and method for annotating an electronic document (see abstract), in which he teaches:

setting a mode of operation to a content capture mode (page 7 lines 10-12);

switching the mode of operation to the annotation mode; and

receiving an annotation drawn on the display via the input device (Figs. 4 and 5, page 7 lines 5-12 and lines 24-26 and).

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Dawe by the teaching of Woolf because receiving an annotation drawn on the display would enable users the ability to annotate pages of a document without changing the contents of the document (Woolf, page 2 lines 14-15).

Further regarding claim 28, Dawe in view of Woolf does not teach extracting as additional context information, a property of the underlying data determined to be included in the on-screen region, the property comprising at least one of: a file name, a file identifier, a uniform resource locator (URL), a uniform resource identifier (URI), a folder name, or meta-data.

Hertzfeld teaches a method and apparatus for context sensitive text recognition (see abstract), in which he teaches automatically extracting as additional context information, a property of the underlying data determined to be included in the on-screen region, the property comprising at least one of: a file name, a file identifier, a uniform resource locator (URL), a uniform resource identifier (URI), a folder name, or

meta-data (step 616 in Figure 6, paragraph 38).

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to have further modified Dawe by the teaching of Hertzfeld to enable recognition of predefined types of text and predefined actions to be performed based on the types of text (Hertzfeld, abstract).

Further regarding claim 28, Dawe in view of Woolf and Hertzfeld fails to teach pointing a first pointer from the selected content to the context information; or pointing a second pointer from the selected content to the additional context information.

Barsness teaches a handheld electronic book reader with annotation and usage tracking capabilities (see abstract), in which he teaches: pointing a first pointer from the selected content to the context information; and pointing a second pointer from the selected content to the additional context information (paragraphs 36, 49 and 61-62). (*Barsness teaches a term is associated with a context list that has one or more context records 69, each context record including either a copy of a section of text or a pointer to the actual content in an electronic document. The term represents selected content, and each term may be associated, by pointers, to different contexts of the document.*)

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to have further modified Dawe by the teaching of Barsness to enable improved functionality and utility of electronic documents by enhancing the collaborative and annotative capabilities of electronic book readers or other similar handheld devices capable of rendering electronic documents (Barsness, abstract,

paragraph 22).

      With respect to claim 31, Dawe in view of Woolf, Hertzfeld and Barsness teaches

wherein the annotation is stored as originally drawn as additional context information in

association with the image file (Dawe, col. 7 lines 9-11, 18-20 and 57-65).

Response to Arguments

18.   Applicant's arguments with respect to claims 22, 24, 27, 28, and 31 have been

considered but are moot in view of the new ground(s) of rejection.

19.   Applicant's arguments filed September 3, 2010, regarding claim 10, have been

fully considered but they are not persuasive.   Applicant argues that the Denoue and

Dawe fail to describe two separate sets. The Examiner disagrees. Denoue teaches

selecting content, such as "Increased Awareness" (paragraphs 67, Figure 6). He further

teaches that the object "Awareness" may be selected alone as a standalone object, and

that the content "Increased Awareness" may represent two parts (i.e. two sets of

characters, "Increased" and "Awareness") (paragraphs 71-72). Therefore, Denoue

teaches two separate sets of textual characters.

Conclusion

      Any inquiry concerning this communication or earlier communications from the

examiner should be directed to ALICIA M. LEWIS whose telephone number is

(571)272-5599. The examiner can normally be reached on Monday - Friday, 9 - 6:30,

alternate Friday off.

      If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Charles Rones can be reached on 571-272-4085. The fax phone number

for the organization where this application or proceeding is assigned is 571-273-8300.

      Information regarding the status of an application may be obtained from the

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published applications may be obtained from either Private PAIR or Public PAIR.

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For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a

USPTO Customer Service Representative or access to the automated information

system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Alicia M Lewis/
Examiner, Art Unit 2164
October 21, 2010